



Atty. Docket No.: 9409/2122

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Parmentier et al.  
Serial No.: 09/011,797  
Filed: July 23, 1998  
Titled: Nucleic acid molecules encoding  
peptides having pronociceptive  
properties

Examiner: Murphy, J.

Group Art Unit: 1646

Conf. No.: 1370

**CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8a**

I hereby certify that this correspondence (and any paper or fee referred to as being enclosed) is being deposited with the United States Post Office as First Class Mail on the date indicated below in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Kathleen M. Williams

Name of Person Mailing Paper

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**STATEMENT UNDER 37 C.F.R. §1.608(a)**

Sir:

The Examiner has indicated in the Office Action mailed on October 7, 2003, that Applicants' effort to antedate U.S. Patent No. 5,837,809 (Grandy et al.) was insufficient, because Applicants had not submitted a statement under 37 C.F.R. §1.608(a) alleging that there is a basis upon which Applicants are entitled to a judgment relative to the patentee. Accordingly, Applicants submit this statement alleging that there is a basis upon which Applicants are entitled to a judgement over Grandy et al.

Applicants allege that prior to the earliest filing date of Grandy et al. (August 11, 1995), Applicants' claimed invention was conceived and reduced to practice as evidenced by the following facts.

1. On August 2, 1995, a letter (Exhibit A; previously filed) was sent from Office Van Maldren (Belgium; acting at that time as European counsel to Applicants) to Mr. Altman indicating that a document would be sent to Mr. Altman entitled "Ligand of the ORL<sub>1</sub> Receptor"

for filing as a Provisional Application in the U.S. The letter of August 2, 1995 also requested that Mr. Altman prepare an assignment to be signed by the inventors.

2. On August 3, 1995, a letter (Exhibit B; previously filed) was sent from Knobbe to Office Van Maldren indicating that action was being taken on the request set forth in the August 2<sup>nd</sup> letter.

3. On August 4, 1995, a letter (Exhibit C; previously filed) was sent from Knobbe to Office Van Maldren enclosing an assignment and small entity declaration for signature by Applicants.

4. On August 7, 1995, a letter (Exhibit D; previously filed) was sent via facsimile from Office Van Maldren to Mr. Altman enclosing two specifications (one of which was the specification for the 60/002,368 provisional application), and requesting that the specifications be filed in the U.S. as Provisional patent applications.

5. On August 8, 1995, a facsimile transmittal sheet (Exhibit E; previously filed) was sent from Knobbe to Office Van Maldren indicating that Knobbe was in receipt of the facsimile letter of August 7, 1995, and that they would await the original copies of the documents to arrive by regular mail before filing in the U.S.

6. On August 14, 1995, the original copy of the letter (Exhibit F(1) and (2) ; previously filed) of August 7, 1995 from Office Van Maldren to Mr. Altman was received by Knobbe. Exhibit F1 shows the front of the original copy of the August 7, 1995 letter indicating that the letter had been previously transmitted by telecopier. Exhibit F2 shows the reverse side of the original copy of the letter of August 7, 1995, and shows that the original copy of the letter was received and date stamped by Knobbe on August 14, 1995.

7. On August 15, 1995, U.S. Provisional Application Serial No. 60/002,368 was filed in the U.S. Patent Office.

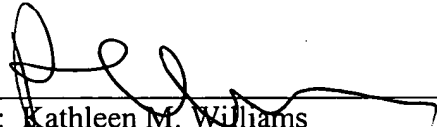
Thus, Applicants' claimed invention was conceived and reduced to practice in the U.S. prior to the earliest effective filing date of Grandy et al. Applicants submit that it is well settled law that the submission of a draft application to a U.S. patent attorney/agent for filing in the U.S. PTO is sufficient to establish a date of conception in the U.S. (See, e.g., *In re Mulder and Wulms*, 716 F.2d 1542 (Fed. Cir. 1983); *Ex Parte Hachiken and Ogino*, 223 USPQ 879 (1984); Exhibits G and H). 37 C.F.R. §1.132 establishes that to antedate a prior art reference, conception of the invention prior to the effective date of the reference must be coupled with due diligence from said date to a subsequent reduction to practice or to the filing of the application. MPEP 2141 (citing *Bey v. Kollonitsch*, 866 F.2d 1024 (Fed. Cir. 1986)) establishes that "reasonable diligence is all that is required of the attorney" (See, *Ex Parte Hachiken and Ogino*, 223 USPQ at 879 (where a gap of seventeen days between receipt of an initial translation of a patent application by U.S. counsel and the eventual filing of the application in the U.S. was deemed by the examiner have met the requisite diligence standard)).

In the present case, a draft of the priority specification was received in the U.S. on August 7, 1995, and thus established the conception of the presently claimed invention in the U.S. As indicated above, Mr. Altman was waiting to receive by regular mail, the original documents for filing in the U.S. It took seven days for the documents to reach Mr. Altman in California from Brussels, Belgium. Upon receipt, Mr. Altman filed the provisional application the following day. Applicants submit that the record shows that with the exception of the seven days it took for the documents to reach Mr. Altman by mail, action was taken in the preparation of the priority provisional application on consecutive day from August 7-8 and 14-15. Thus, Applicants submit that the above facts (as set out in Mr. Altman's Rule 132 Declaration filed on July 17, 2003) establishes that the present invention was conceived in the U.S. prior to the earliest effective filing date of Grandy et al., and was diligently reduced to practice via the filing of U.S. Provisional Application No. 60/002,368 on August 15, 1995.

Applicants submit that the above statements and facts allege that Applicants have a basis on which to be entitled to a judgment relative to Grandy et al., and further submit that the date of invention of the present invention antedates than of Grandy et al.

Respectfully submitted,

Date: March 29, 2004



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